

REMARKS

Claims 1-19 are pending in the application.

Claims 1-19 are subject to a Restriction Requirement dated August 31, 2006.

Claims 4-19 have been withdrawn with traverse herein.

Claims 1-3 remain pending in this application.

Reconsideration of the claims is respectfully requested.

RESTRICTION REQUIREMENT:

In the Restriction Requirement dated August 31, 2006, the Examiner proposes to restrict the present application under 35 U.S.C. §121 into six (6) inventions (or Groups 1-6). Applicant provisionally elects the claims of Group I, Claims 1-3, WITH TRAVERSE.

In every requirement to restrict, the Examiner must show by appropriate explanation: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be serious burden on the Examiner if the restriction is not required. *MPEP* § 808.02, p. 800-53 (8th ed., rev. 5, August 2006). In addition, the Examiner must show by appropriate explanation at least one of the following: (A) separate classification; (B) separate status in the art when they are classifiable together; or (C) a different field of search. *Id.* Where, however, the classification and field of search are the same, and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions. *Id.* (emphasis added). A combination is an organization of which a subcombination or element is a part. *Id.* at § 806.05(a), p. 800-44. Each subcombination is distinct from the combination as claimed if: (A) the combination

does not require the particulars of the subcombination as claimed for patentability; and (B) the subcombination can be shown to have utility either by itself or in another *materially different combination*. *Id.* at § 806.05(d), p. 800-46 (emphasis added).

Groups 1-6 are classified in the same U.S. Patent and Trademark Office classification, class 716, subclass 5. Accordingly, the Office is not burdened with searching more than one subclass for Groups 1-6 (*i.e.*, the field of search for Groups 1-6 is the same).

In addition, Groups 1 and 2 are both directed to a circuit. Group 1, however, requires, for example, (1) “a multiplexer to *select said configuration vector* for loading into said scan chain elements”; and (2) “a clock generator to *clock said configuration vector* into said scan chain elements.” (emphasis added). Group 2, on the other hand requires, for example: (1) “a *circuit for receiving a test vector* for clocking into said scan chain elements”; (2) “a *multiplexer to select between said configuration vector and said test vector* for loading into said scan chain elements”; and (3) a clock generator to clock said *selected vector* into said scan chain elements. As claimed, the multiplexer in Group 2 selects between two elements (*i.e.*, the configuration vector and the test vector). In cases where, for example, the multiplexer in Group 2 selects the test vector, Groups 1 and 2 are materially different combinations and cannot be characterized as a combination and subcombination as suggested by the Examiner. Groups 1 and 2 therefore should not be subject to a restriction requirement.

As another example, Groups 4 and 5 are both directed to a method of reducing leakage currents in a circuit. Group 4, however, requires, for example, “selectively clocking either a test data vector or a configuration vector into scan chain elements for application to circuit elements

within said circuit, wherein when said configuration is clocked into said scan chain elements, said configuration vector configures said circuit elements into a state in which leakage currents are reduced.” Group 5, on the other hand, requires, for example, “clocking said vector into scan chain elements of said circuit for application thereby to said circuit elements when said operating mode is detected.” In cases where, for example, the second operating mode is detected in Group 6, Groups 5 and 6 are materially different combinations and cannot be characterized as a combination and subcombination as suggested by the Examiner. Groups 5 and 6 therefore should not be subject to a restriction requirement.

Similar arguments exist for Groups 1-6. Accordingly, the Applicant respectfully requests the Examiner to withdraw the restriction requirement.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

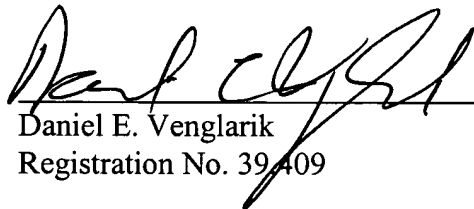
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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